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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,852	07/08/2002	Petr Kvita	HF/S-22102/A/PCT	5257

324 7590 11/18/2003

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PATENT DEPARTMENT
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EXAMINER	
HARDEE, JOHN R	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/089,852	KVITA ET AL.	
	Examiner	Art Unit	
	John R Hardee	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-40* is/are pending in the application.

4a) Of the above claim(s) *35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-34 and 36-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *21-40* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

1. A number of foreign references are present in the file, but no IDS could be found. Assuming that applicant submitted one, the Office has misplaced it. The examiner apologizes for the inconvenience.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 21-40, drawn to methods of use of compositions comprising a polyethylene additive.

Group II, claim(s) 21-40, drawn to methods of use of compositions comprising a fatty acid alkanolamide additive.

Group III, claim(s) 21-40, drawn to methods of use of compositions comprising a polysilicic acid additive.

Group IV, claim(s) 21-40, drawn to methods of use of compositions comprising a polyurethane.

3. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Any feature which unites the inventions fails to make a contribution over the prior art in view of the references marked "X" in the PCT Search Report.

4. During a telephone conversation with Mr. Kevin Mansfield on November 13, 2003, a provisional election was made with traverse to prosecute the invention of Group I, claims 21-40. Affirmation of this election must be made by applicant in replying to this Office action. Claim 35 was withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, and the other claims were searched and examined only to the extent that they read on the elected invention. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-34 and 36-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-40 of copending Application No. 10/089,850. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '850 are drawn to compositions of the same scope as the methods presently claimed. It would have been obvious at the time that the invention was made to use the compositions presently claimed to treat fabric, as that utility is recited in the claims of the '850.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 21-34 and 36-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-40 of copending Application No. 10/089,853. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to methods of treating laundry, although the intended outcomes of the treatment are different. It would have been obvious at the time that the invention was made to treat fabric as presently claimed, because the '852 claims treatment of fabric with compositions of identical scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 21-24, 26, 28-34, 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 397,245. See Example VII, p. 20. The disclosed composition is combined with the perfume particles of Example II, which comprise polyethylene. Silicone oil is well known in the surfactant at as being synonymous with polydimethylsiloxane, and the examiner takes the position that the disclosed viscosity would meet applicant's molecular weight limitations. Compositions containing triple or quadruple the disclosed amount of actives may be made as well, meeting the limitations of claims 29 and 30. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a fabric softening composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim,* 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff,* 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990). While increase of hydrophilicity is not disclosed, such would follow from using the compositions in the disclosed manner.

12. Claims 21-24, 26-34, 36 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 459,822 A2 in view of EP 397,245 A2. The '822 discloses liquid and dryer sheet fabric softening compositions containing compatible silicones. Suitable silicones are of the form shown on pp. 5-8 and in the examples. Additions of small amounts of polydimethylsiloxane is disclosed at p. 9, lines 20-21. Preferred fabric softeners are disclosed at p. 3, lines 38+. Production of clear compositions is disclosed at p. 3, lines 5+. Formulation of dryer sheets id disclosed at p. 10, lines 22+. Addition of polyethylene is not disclosed.

The '245 is summarized above. It would have been obvious at the time that the invention was made to incorporate the perfume-polyethylene particles of the '245 into the fabric softening compositions of the '822, because the '822 discloses at p. 9, line 26 that perfumes may be added, and the '245 teaches at p. 14, lines 24+ that the perfume-polyethylene particles taught therein are useful in liquid and dryer sheet fabric softening compositions. While increase of hydrophilicity is not disclosed, such would follow from using the compositions in the disclosed manner.

13. Claims 21-24, 26, 28-34, 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooney, US 5,965,517. The reference discloses liquid fabric softening compositions comprising silicone and polyethylene (see examples). These compositions reduce wrinkling of treated fabric. Suitable fabric softeners are disclosed at col. 3, lines 27+. Suitable silicones include polydimethylsiloxanes, and are disclosed at col. 5, lines 52+. A preferable pH range of 1.5-5 is disclosed at col. 6, lines 61-62. This reference differs from the claimed subject matter in that it does not disclose a

composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a fabric softening composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary. While increase of hydrophilicity is not disclosed, such would follow from using the compositions in the disclosed manner.

Allowable Subject Matter

14. Claims 25 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and provided that the double patenting rejections were overcome.

15. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record is the references relied upon above. They do no disclose or motivate the use of a silicone as recited in claim 25 in a fabric softening composition in conjunction with a polyethylene, nor do they disclose the method of making such a fabric softening composition as recited in claim 37.

16. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

John R. Hardee
Primary Examiner
November 13, 2003